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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,161	06/25/2004	Shin-ya Matsunaga	1155-0279PUS1	7426
2292 7590 01/19/2007 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			EXAMINER PENG, KUO LIANG	
			ART UNIT	PAPER NUMBER
			1712	
SHORTENED STATUTORY PERIOD OF RESPONSE		NOTIFICATION DATE	DELIVERY MODE	
3 MONTHS		01/19/2007	ELECTRONIC	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 01/19/2007.

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Office Action Summary

Application No.

10/500,161

Applicant(s)

MATSUNAGA ET AL.

Examiner

Kuo-Liang Peng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 1/5/07 RCE.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16,17 and 22-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16,17 and 22-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 June 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed October 10, 2006 and January 5, 2007 have been entered. Claims 1-15 and 18-21 are deleted. Claims 16-17 are amended. Claims 22-27 are added. Now, Claims 16-17 and 22-27 are pending.

2. The text of those sections of Title 35, U.S. code not included in this action can be found in prior Office Action(s).

Claim Rejections - 35 USC § 102

3. Claims 16-17, 22 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Hakuta407 (WO 01/98407).

The following column and line numbers are based on Hakuta407's U.S. equivalent, US 6 743 862.

Hakuta407 discloses a method of preparing molded products (col. 22, lines 36-48 and Examples) made of various rubber compositions such as a rubber composition comprising components A), B), C), D) and E) (col. 2, line 64 to col. 4, line 53), etc. The detailed characteristics of each components are further described in col. 6, line 46 to col. 15, line 7. The rubber composition can be useful for sealing or gasket material. (col. 5, lines 10-18, 39-46 and 61-63) Note that “for fuel cell seal”, “for a hard disk driver” and “top cover” are merely intended uses, and do not carry any weight of patentability. See MPEP 2111.02. The composition can be **kneaded**. (col. 22, lines 23-36) The molding process can be **injection molding**. (col. 22, lines 36-48) The **intrinsic viscosity** of component A) is described in col. 3, lines 53-60. Component B) can be **liquid**. (col. 11, line 61 to col. 13, line 60) The injection molding process should be a **liquid injection molding** because the composition reads on Applicants’ composition. Molding and crosslinking can be carried out **consecutively**. (col. 22, lines 36-48)

For Applicants’ argument (Amendment of 10/10/06, Remarks, page 7, last paragraph), the claimed organopolysiloxane B) is not necessarily present.

For Applicants’ argument (Amendment of 10/10/06, Remarks, page 8, 1st paragraph and Amendment of 1/5/07, Remarks, page 7, 2nd paragraph), in view of the rejection, *supra*, the argument is moot.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 16-17 and 22-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hakuta251 (WO 00/55251).

The following column and line numbers are based on Hakuta251's U.S. equivalent, US 6 864 315.

Hakuta251 discloses a method of preparing molded products (col. 6, lines 20-32 and Examples) made of various rubber compositions such as a rubber composition comprising components A), B), E) and F) (col. 7, lines 19-50), a rubber composition comprising components A), B), C), E) and F) (col. 14, line 48 to col. 15, line 40), a rubber compositions comprising components A), B), E), F) and with or without organopolysiloxane of formula (I) (col. 23, line 35 to col. 25, line 44), etc. The detailed characteristics of each components are further described

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in col. 26, line 55 to col. 39, line 28 and col. 40, line 7 to col. 41, line 42. The rubber composition can be useful for sealing or gasket material. (col. 2, lines 6-19, col. 4, lines 55-60, col. 5, lines 1-13 and col. 6, lines 53-58) Note that “for fuel cell seal”, “for a hard disk driver” and “top cover” are merely intended uses, and do not carry any weight of patentability. See MPEP 2111.02. The composition is **kneaded** and **crosslinked**. Molding and crosslinking can be carried out **consecutively** or **simultaneously**. The composition can be crosslinked by means of **hot air**, **fluidized bed**, etc. (col. 49, lines 1-62) The composition can be in a **liquid** form because components A) and B) can be liquid. (col. 33, line 39 to col. 34, line 33 and col. 49, lines 54-62) The composition can be **injection molded**. (col. 3, lines 21-29) Therefore, Hakuta251 does teach molding the composition by **liquid injection molding**. Component A can have an intrinsic viscosity as low as 0.3 dl/g. (col. 21, lines 35-54) Hakuta251 is silent on the specific claimed intrinsic viscosity. However, Hakuta251 teaches that in general a **decrease** in the **viscosity** of a composition is **desirable**. The motivation is to enhance the processability thereof. (col. 2, lines 24-38) Note that the viscosity of component A) can ultimately affect that of the composition. In light of the benefit mentioned, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilize component A) having the claimed intrinsic viscosity in order to afford a

composition with a desired viscosity with expected success. Especially, Applicants do not show the **criticality** of the viscosity.

For Applicants' arguments (Amendment of 10/10/06, Remarks, page 7, 3rd and 4th paragraphs and page 8, 1st paragraph to page 9, 2nd paragraph and Amendment of 1/5/07, Remarks, 2nd paragraph), in view of the rejection, supra, the arguments are moot.

6. Claims 23 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hakuta407 (WO 01/98407/US 6 743 862), optionally in view of Hakuta251 (WO 00/55251/US 6 864 315).

Hakuta407 discloses a method of preparing molded products, supra, which is incorporated herein by reference. Hakuta407 is silent on a liquid injection molding where the molding and crosslinking are carried out simultaneously. However, Hakuta251 teaches a press molding where the molding and crosslinking are carried out simultaneously. (col. 9, lines 6-12) In light of which, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to perform a liquid injection molding where the molding and crosslinking are carried out **simultaneously**. The motivation is to eliminate a separate step of curing. Alternatively, as set forth in paragraph 5 above, Hakuta251 teaches a liquid

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injection molding where consecutive molding/crosslinking and simultaneous molding/crosslinking are interchangeable. (col. 49, lines 27-42) In light of which, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to **simultaneously** mold/crosslink the composition with expected success. Especially, Applicants do not show the **criticality** of the claimed molding/crosslinking process. See MPEP 2144.06.

7. Claims 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hakuta407 (WO 01/98407/US 6 743 862) in view of Hakuta251 (WO 00/55251/US 6 864 315).

Hakuta407 discloses a method of preparing molded products, *supra*, which is incorporated herein by reference. Hakuta407 is silent on the claimed crosslinking process. However, Hakuta251 teaches curing a composition substantially the same as that of Applicants' by means of **HAV**, etc. The motivation is to afford a cured product with excellent properties and **crosslinking rate**. (col. 22, lines 4-12) In light of the benefit mentioned, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilize Hakuta251's method for curing Hakuta407's composition with expected success. Especially, Hakuta251 is

in the same field as that of Hakuta407's endeavor, and Applicants' do not show the **criticality** of the claimed crosslinking method.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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klp

January 12, 2007


Kuo-Liang Peng
Primary Examiner
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